



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,576	05/11/2006	Barbara Muller	BOET 22.623(336348-00017)	9612
26304 7590 09/10/2009 KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			EXAMINER WILSON, JOHN J	
			ART UNIT 3732	PAPER NUMBER
			MAIL DATE 09/10/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/564,576	Applicant(s) MULLER, BARBARA	
	Examiner John J. Wilson	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 2-5, 10, 12 and 16-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6-9, 11, 13-15 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 January 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/13/06 5/4/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Species III in the reply filed on April 10, 2009 is acknowledged. The traversal is on the ground(s) that Species I and III are defined by cross-sectional area while Species II is not, and therefore, Species II is not a proper different Species. This is not found persuasive because the restriction is based on Species comprising different shapes which function differently. While some of the Species define shape by cross-section and one does not, this does not preclude their different shapes from being different Species.

The requirement is still deemed proper and is therefore made FINAL.

Claims 2-5, 10, 12 and 16-22 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on April 10, 2009.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not show or

Art Unit: 3732

teach how to make and use a periphery of a cross-sectional area comprising a honeycomb structure. It is believed and assumed that this is referring to a shape that, if combined with other similar shapes, could be formed into a honeycomb, for example, a triangular or pentagonal or hexagonal shaped periphery.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6, 8, 11 and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Wall (4372314). Wall shows a dental insertion element 30 having a non-circular periphery, Fig. 3. As to claim 6, the shape shown in Fig. 3, is that of a closed polygon.

Claims 1, 6, 7 and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones (3607520). Jones shows an insertion element, Fig. 1b, having a non-circular periphery of a closed polygon. As to claim 7, as best understood, Jones shows a honeycomb periphery structure. All of the actual claimed structure being shown, the intended use as a dental insertion element is met because the prior art structure is capable of being used in a dental procedure.

Claims 1, 6, 8, 11 and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Lempert (2180249). Lempert shows a dental insertion element 8 having a non-circular periphery in a polygonal shape as shown.

Claims 1, 6, 8, 13-15 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Mattson (4293301). Mattson shows a dental insertion element, Fig. 3, having a cross-section with a non-circular periphery because a cross-section taken at the location of numerals 10B and 15 shown in Fig. 3 would be a rectangle.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wall (4372314). Wall shows the structure as described above, however, does not show a periphery of a cross-sectional area that is a honeycomb structure or a triangular shape. The specific polygonal shape used is an obvious matter of choice in the specific shape of a known element to one of ordinary skill in the art.

Art Unit: 3732

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wall (4372314) in view of Mattsson (4293301). Wall shows the structure as described above, however, does not show an endless string of elements. Mattsson shows a string of elements. It would be obvious to one of ordinary skill in the art to modify Wall to include a string of elements as shown by Mattsson in order to more conveniently package the elements.

Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lempert (2180249). Lempert shows the structure as described above, however, does not show a periphery of a cross-sectional area that is a honeycomb structure or a triangular shape. The specific polygonal shape used is an obvious matter of choice in the specific shape of a known element to one of ordinary skill in the art.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lempert (2180249) in view of Mattsson (4293301). Lempert shows the structure as described above, however, does not show an endless string of elements. Mattsson shows a string of elements. It would be obvious to one of ordinary skill in the art to modify Lempert to include a string of elements as shown by Mattsson in order to more conveniently package the elements.

Information Disclosure Statement

The information disclosure statement filed January 13, 2006 has been considered, the cited foreign documents have not been considered and have been crossed through because copies

Art Unit: 3732

of these documents have not been furnished as required. The information disclosure statement filed May 4, 2007 has been considered. Copies of both are attached.

Drawings

The drawings filed January 13, 2006 are objected to as using hand drawn lines.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed polygonal shapes and endless string must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Wilson whose telephone number is 571-272-4722. The examiner can normally be reached on Maxi-Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on 571-272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/John J Wilson/
Primary Examiner
Art Unit 3732**

September 9, 2009